

## **REMARKS**

Claim 13 has been canceled without prejudice.

Claims 1 and 7 have been amended to specify that the reaction portion is “in contact with the receiving portion” and that the reaction portion is “in contact with” the reservoir, respectively. Support for these claim amendments can be found throughout the specification, for example, on page 53, lines 14-17 and in Figs. 20 and 21 A-D. Claims 2 and 3 have been amended to replace the word “receiver” with the word “receiving.” Support for these claim amendments can be found throughout the specification and in original claim 1. Claim 7 has been amended to specify that the reaction portion comprises a capillary tube. Support for this claim amendment can be found throughout the specification, for example, on page 53, line 1 through page 54, line 32 and in original claim 10. Minor amendments have been made to claim 10.

Applicants acknowledge that these amendments are being made after final rejection and that entry of amendments after final rejection is at the Examiner’s discretion. These amendments were not presented earlier because it was believed that they were not necessary to complete response to the last office action. Further the amendments are responsive to the Examiner’s comments in the present office action, they put the claims in condition for allowance or in better form for appeal, and they do not raise any new issues or require further search. Applicants respectfully request that the Examiner exercise his discretion in favor of entry of these amendments under these circumstances.

Applicants wish to thank the Examiner for the courtesies extended by the Examiner in the telephonic interview with Applicants’ undersigned attorney on October 20, 2004. It is Applicants’ understanding that this response will lead to allowance of the pending claims if the Examiner does not identify any additional art to be cited in the captioned application.

The Examiner has rejected claims 1-3, 5-9, 14 and 15 under 35 U.S.C. § 102(e) as being anticipated by Seubert et al. (U.S. Patent No. 5,785,926; the ‘926 patent). The Examiner

indicates that the '926 patent discloses a container for holding a fluidic biological sample that includes a receiving portion and a reaction portion as specified in independent claim 1, and its dependent claims 2-3 and 5-6, and independent claim 7, and its dependent claims 8-9, 14, and 15. The receiving portion, according to the Examiner, comprises the parts of the device disclosed in the '926 patent with reference numerals 54, 84, and 94 as shown in Fig. 17.

In the previous office action mailed on February 13, 2004, the Examiner argued that the receiving portion of the device disclosed in the '926 patent comprises the parts of the device with reference numerals 54, 84, and 94 as shown in Fig. 17 of the '926 patent. The Examiner has now broadened this argument and is also making a new argument based on this reference (see section titled "Response to Arguments" on pages 6-8 of the August 11, 2004 office action).

First, the Examiner has broadened his previous argument and contends that when the cap (reference numeral 94) and the tube (reference numeral 38) are separated from the rest of the device shown in Fig. 17 of the '926 patent, the cap (reference numeral 94) forms a receiving portion as claimed in independent claims 1 and 7 (see pages 6-7 of section titled "Response to Arguments" of the August 11, 2004 office action).

As discussed in Applicants' previous response, the device shown in Fig. 17 of the '926 patent is a device for sample collection that functions as a pneumatic piston resulting in withdrawal of fluid from a container, such as a microtiter plate, and into the capillary tube (reference numeral 38). The device functions in a manner similar to a standard laboratory pipette. In the device shown in Fig. 17, the capillary tube (reference numeral 38) is held in place by an O-ring (reference numeral 98) that is held in place by pressure exerted by the adapter (reference numeral 84) when the adapter is in place in the device (*i.e.*, when the adapter with its threaded portion (88) is screwed into place into the cap (reference numeral 94)).

Accordingly, if the cap (reference numeral 94) and the tube (reference numeral 38) are separated from the rest of the device, there is nothing to hold the capillary tube in place and fluid placed in the "receiving portion" (reference numeral 94) would simply leak out the bore

(reference numeral 92). Not only would the device depicted in Fig. 17 of the '926 patent be inoperable for the purpose described in the '926 patent, but the device would be inoperable to function as the device claimed in independent claims 1 and 7. Thus, the Examiner's argument is improper because the Examiner's argument is directed to an inoperable device.

Second, the Examiner is making a new argument based on the '926 patent (see page 7, line 18 through page 8, line 1 of section titled "Response to Arguments" of the August 11, 2004 office action). The Examiner contends that the chambers with reference numerals 86 and 90 are capable of receiving a biological sample and meet the limitations of the "receiving portion" specified in claims 1 and 7.

Anticipation exists only if all the elements of the claimed invention are present in a product or process disclosed, expressly or inherently, in a single prior art reference. *Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984). Claims 1 and 7 have been amended to specify that the reaction portion is "in contact with the receiving portion" or that the reaction portion is "in contact with" the reservoir, respectively. In the '926 patent, the "reaction portion" (reference numeral 38) is not in contact with the "receiving portion" because there is an O-ring (reference numeral 98) and a washer (reference numeral 96) that separate the capillary tube ("reaction portion" (reference numeral 38)) from the portion of the device depicted in Fig. 17 labeled with reference numeral 90. Thus, the "reaction portion" (reference numeral 38) of the device depicted in Fig. 17 of the '926 patent is not in contact with either the part of the device labeled with reference numeral 86 or the part of the device labeled with reference numeral 90 (what the Examiner calls the "receiving portion"). Thus, the '926 patent cannot anticipate claims 1-3, 5-9, 14, and 15. Withdrawal of the rejection of claims 1-3, 5-9, 14 and 15 under 35 U.S.C. § 102(e) is respectfully requested.

The Examiner also rejected claims 4, 10, 17, and 18 under 35 U.S.C. § 103(a) as being obvious over the '926 patent. Claim 4 depends from independent claim 1 and claims 10, 17, and 18 depend from independent claim 7. Thus, claims 4, 10, 17, and 18 specify that the reaction portion is in "in contact with the receiving portion" (claim 4) or that the reaction portion

is “in contact with” the reservoir (claims 10, 17, and 18). As discussed above with respect to the rejection under § 102(e), in the device shown in Fig. 17 of the ‘926 patent, the “reaction portion” (reference numeral 38) is not in contact with the “receiving portion” because there is an O-ring (reference numeral 98) and a washer (reference numeral 96) that separate the capillary tube (“reaction portion” (reference numeral 38)) from the portion of the device depicted in Fig. 17 labeled with reference numeral 90. Thus, the arguments discussed above with respect to the § 102(e) rejection apply with equal force to this rejection. Accordingly, the ‘926 patent does not describe a reaction portion “in contact with” a receiving portion as specified in claims 4, 10, 17, and 18 and cannot render the subject matter of claims 4, 10, 17, and 18 obvious. Withdrawal of the rejection of claims 4, 10, 17, and 18 under 35 U.S.C. § 103(a) is respectfully requested.

The Examiner also rejected claim 12 under 35 U.S.C. § 103(a) as being obvious over the ‘926 patent in view of Bauman et al. (U.S. Patent No. 3,876,376; the ‘376 patent). Claim 12 incorporates the subject matter of claims 7, 10, and 11. Because claim 12 incorporates the subject matter of claim 7, the arguments discussed above with respect to the ‘926 patent apply with equal force to this rejection. Furthermore, claim 12 incorporates the subject matter of claim 10. Claim 10 requires that the reaction portion comprises a capillary tube having a 0.8 mm inner diameter and a 1.0 mm outer diameter. Neither the ‘926 patent nor the ‘376 patent describes or even mentions a capillary tube having a 0.8 mm inner diameter and a 1.0 mm outer diameter. Thus, the subject matter of claim 12 cannot be obvious over the ‘926 patent in view of the ‘326 patent. Withdrawal of the rejection of claim 12 under 35 U.S.C. § 103(a) is respectfully requested.

The Examiner also rejected claims 7-9 and 13-18 under 35 U.S.C. § 103(a) as being obvious over Muller (U.S. Patent No. 5,260,032; the ‘032 patent). Claim 7 has been amended to specify that the reaction portion “comprises a capillary tube.” The ‘032 patent does not describe a reaction portion that “comprises a capillary tube.” The ‘032 patent discloses a device used to prepare microscope slide specimens as shown in Fig. 1 of the ‘032 patent. According to the Examiner, the “reaction portion” of the device disclosed in the ‘032 patent is

the microscope slide. The '032 patent makes no suggestion and does not even mention a "reaction portion" that comprises a capillary tube. Accordingly, the subject matter of claims 7-9 and 13-18 cannot be obvious over the '032 patent. Withdrawal of the rejection of claims 7-9 and 13-18 under 35 U.S.C. § 103(a) is respectfully requested.

### **CONCLUSION**

The foregoing amendments and remarks are believed to fully respond to the Examiner's rejections. The claims are in condition for allowance. Applicants respectfully request allowance of the claims, and passage of the application to issuance.

Respectfully submitted,  
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